

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Office Action mailed on August 4, 2008. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Claims 1-32 are pending.

Claim Rejections under 35 U.S.C §103

Claims 1-4, 6-12, 14-18, and 23-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cornwall et al. (U.S. Patent No. 6,485,518) in view of Davison (U.S. Patent No. 6,530,926). This rejection is respectfully traversed.

The Examiner asserts that Cornwall et al. teach the step of positioning a cannula at a preferred angle to perform a percutaneous procedure, and asserts that this is considered inclining. Applicants respectfully disagree. One of ordinary skill in the art would not consider the step of placing a cannula into the body at a preferred angle as a positive method step of "after said inserting step, inclining said access device from a plane that is generally perpendicular to the spine of the patient" as recited in claims 1 and 14. MPEP 2111 states:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

415 F.3d at 1316, 75 USPQ2d at 1329. See also< *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

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The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

Applicants submit that one of ordinary skill in the art, upon reading the specification, would not interpret the claims as reciting merely positioning a cannula at an angle. In particular, the claims specifically state that the inclining step is after the inserting step, indicating two actions are performed: (1) inserting an access device, and (2) inclining the access device. Cornwall et al. do not appear to teach or suggest such specific steps. Further, the Examiner's assertion that the positioning step of Cornwall et al. meets the inserting and inclining steps appears to be an acknowledgement that Cornwall et al. do not teach a separate inclining step.

The Examiner also asserts that the term "crossing" is interpreted as the same thing as inclining. Applicants respectfully disagree. As discussed above, the claims recite separate inserting and inclining steps, while Cornwall et al. appear to teach a single step of inserting a cannula at a desired angle. Whether Cornwall et al. may teach inserting a cannula at an angle that crosses a midline appears to be irrelevant with regard to any teaching of a specific method step of inclining an access device after the access device is inserted to a desired location. The Examiner appears to assert, on page 3 of the Office Action, that Davison teaches the step "of the device moving from a plane generally perpendicular to the spine of the patient at an established angle", but does not provide any support for the assertion. The Examiner then asserts that the cannula may be slightly angled to complete the procedure and deliver the screws. The Examiner provides no support for this assertion. Neither Cornwall et al. nor Davison appear to teach such specific steps. The Examiner appears to be asserting that the claimed method steps are inherent in Cornwall et al. and/or Davison, or that one could perform the claimed method using the devices of Cornwall et al. and/or Davison. The Examiner is reminded that MPEP 2112 IV. states that inherency requires a feature to be necessarily present. There is no teaching or suggestion that the specifically recited method steps are necessarily present in either Cornwall et al. or Davison. Additionally, the Examiner has failed to provide any reasoned statements of motivation for performing the specific method steps recited in the claims. The Examiner provides no support for the mere conclusion of obviousness.

Additionally, Cornwall appears to teach a preferred method and system involving inserting 2 facet screws, where each screw is inserted through a separate narrow cannula at a specific angle through two vertebra. As discussed in the response filed February 20, 2007, at page 10, third paragraph, it would appear that if an enlarged/expandable elongate body, as discussed in Davidson, were used in the method disclosed in Cornwall, it would defeat the purpose of Cornwall's specifically oriented guideframes that orient narrow cannulae to deliver narrow implants to specific locations at specific orientations. In other words, Cornwall thus appears to teach away from replacing their narrow cannula in the facet screw placement procedure with the enlarged/expandable elongate body of Davidson. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 5 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over R Cornwall et al. (U.S. Patent No. 6,485,518) and Davison (U.S. Patent No. 6,530,926) as applied to claims 1 and 8, respectively above, and further in view of Neubardt (U.S. Patent No. 5,196,015). This rejection is respectfully traversed. As discussed above, there is no motivation for one of ordinary skill in the art to combine Davison and Cornwall, and even if such a combination were made, the elements of independent claim 1, from which claims 5 and 13 depend, are not taught or suggested. Naubardt does not appear to provide what Davison and Cornwall lack. Naubardt does not appear to provide any motivation or suggestion for modifying Davison and/or Cornwall to achieve the method steps recited in independent claim 1, or dependent claims 5 and 13. This rejection is thus in error.

Claims 19-20 and 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Cornwall et al. (U.S. Patent No. 6,485,518) and Davison (U.S. Patent No. 6,530,926). This rejection is respectfully traversed. For at least the reasons set forth above, Cornwall et al. and Davison do not appear to teach or suggest the elements of independent claims 1 and 14, from which claims 19-20, and 21-22 depend, respectively. There is no motivation for one of ordinary skill in the art to further modify Cornwall et al. and/or Davison to achieve the specific method steps recited in claims 19-22. Reconsideration and withdrawal of the rejections are respectfully requested.

CONCLUSION

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

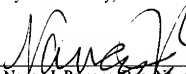
Respectfully submitted,

Gene DIPOTO et al.

By their attorney,

Date: _____

11/4/08



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